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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,013	09/11/2003	Dustin C. Kirkland	AUS920030632US1	5894
35525	7590	03/09/2007		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER LY, ANH	
			ART UNIT 2162	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/660,013	Applicant(s) KIRKLAND ET AL.	
	Examiner Anh Ly	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/11/2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/11/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is response to Applicants' Communications filed on 09/11/2003.
2. Claims 1-14 are pending in this Application.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 14 is rejected under 35 U.S.C. 101 because the bodies of claim 14 in view of MPEP 2106 (IV)(C)(2)((1) & (2) & (a) & (b) & (c)) sections are non statutory because they are **lacking of real world useful result**. ^{it is} ~~They are~~ missing the steps or processes producing any useful result to the invention, of having a utility to convey the final result achieved by the claimed invention, that is, they are not producing a result tied to the real/physical world or this application is not a practical application. That is, this claim is missing "**utility requirement**" of 35 U.S.C. 101 (the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible (MPEP 2107.01), this claim must show that the claimed invention is "useful" for some purpose either explicitly or implicitly (Fisher, 421, F.3d 1356, 76 USPQ2d at 1230 and 1225 (Fed. Cir. 2005). Thus, requiring the applicant to distinguish the claim from the three 35 U.S.C. 101 judicial exceptions (Laws of Nature, Natural Phenomena and Abstract Ideas) (MPEP 2106 IV C) to patentable subject matter by specifically reciting in the claim the practical application. A claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application. In other words, if the specification

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discloses a practical application of a section 101 judicial exceptions, but the claim is broader than the disclosure such that it does not require a practical application, then the claim must be rejected. That is, it require that the claim must recite more than 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produce a real-world result (Benson, 409 U.S. at 71-72, 175 USPQ at 676-77) and the process must have a result that can be substantially produce the same result again and must achieve the required status of having real world value or to be realized as "useful result". (In re Swartz, 232 F3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)).

5. Claim 14 is a "computer program product", which is as a "computer-executable program" stored on a computer-readable medium such as CD without executing directly or positively by a physical object or machine or computer system. It is descriptive material per se. Also, the medium as in the application specification was specified as transmission-type media such as digital and analog communications links, wired or wireless communications links using transmission forms such as Radio Frequency and light wave transmission or signals (see spec. page 18, lines 14-30 or section 0047 in Pub. No.: US 2005/0060291 A1 dated 03/17/2005 of this application), which is also non-statutory subject matter. Thus, it is **descriptive material per se**. The descriptive material includes non-functional and functional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional

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descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101. (MPEP 2106.01 [R-5] - Computer-Related Nonstatutory Subject matter).

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or act to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are

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nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Patent No.: US 7,136,932 B1 issued to Schneider.

With respect to claim 1, Schneider teaches a method in a data processing system for searching for Web pages within a Web site (a system for searching web pages from one of search engines to locate web pages or hits within a Web site from clients (item 110): see fig. 1a and 1b, and col. 17, lines 34-44; also col. 10, lines 58-67), the method comprising:

receiving a search statement as a result of a user input, wherein the search statement includes a universal resource identifier and a regular expression (receiving the input search request or search or query string including URI or string of characters for identifying an abstract or physical resource from the client of the system: see fig. 2a, col. 4, lines 30-56 and col. 18, lines 30-56);

retrieving universal resource identifiers associated with the universal resource identifier in the request to form retrieved universal resource identifiers (retrieving from a database to generate valid URIs based on the search string: fig. 16 and col. 34, lines 18-32);

parsing the retrieved universal resource identifiers for the regular expression to form search results (parsing retrieved URIs via a parsing schema: see fig. 2b, item 260 and 2a, item 210: col. 21, lines 48-63; also col. 30, lines 30-42 and col. 18, lines 30-55); and

returning the search results, wherein the search results include a list of universal resource identifiers associated with the Web pages within the Web site (the result of the search is displayed (item 222 in fig. 2a) and as a list of valid URIs (fig. 13): col. 30, lines 22-30 and col. 18, lines 40-55).

With respect to claim 2, Schneider teaches wherein the search results are returned as a Web page, wherein the universal resource identifiers are presented as a set of links, wherein selection of a link within the set of links causes a Web page identified by the link to be retrieved (the result is a list of URI or a set of web pages,

which is also a hyperlinks: fig. 13, col. 30, lines 22-30; also see col. 17, lines 35-45 and col. 18, lines 5-12).

With respect to claim 3, Schneider teaches wherein the regular expression is separated from the universal resource identifier by a delimiter (delimiters in the search string: fig. 18, col. 39-55; col. 19, lines 45-65 and col. 35, lines 58-67).

With respect to claim 4, Schneider teaches wherein the universal resource identifier is a domain name (paring the search string including domain name: col. 18, lines 40-67 and col. 19, lines 1-20).

With respect to claim 5, Schneider teaches wherein the parsing step includes: searching a table of contents for a match to the regular expression, wherein the table of contents contains the retrieved universal resource identifiers (a table of generated URIs: fig. 13).

With respect to claim 6, Schneider teaches wherein retrieving, parsing, and returning steps are performed by a server hosting a Web site identified by the universal identifier, a proxy server, or a client at which the user input was entered (parsing and returning the result from a web server and proxy server: col. 22, lines 8-67 and col. 25, lines 27-52).

Claim 7 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 8 is essentially the same as claim 1 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 9 is essentially the same as claim 2 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 10 is essentially the same as claim 3 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 11 is essentially the same as claim 4 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 12 is essentially the same as claim 5 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 5 hereinabove.

Claim 13 is essentially the same as claim 6 except that it is directed to a data processing system rather than a method, and is rejected for the same reason as applied to the claim 6 hereinabove.


Claim 14 is essentially the same as claim 1 except that it is directed to a computer program product rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.


Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANH LY, whose telephone number is (571) 272-4039 or via e-mail: ANH.LY@USPTO.GOV (**written authorization being given by Applicant(s) - MPEP 502.03 [R-2]**) or fax to (571) 273-4039 (examiner's personal fax number).

The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John Breene**, can be reached on (571) 272-4107.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: **Central Fax Center: (571) 273-8300**

ANH LY 
FEB. 22th, 2007


JOHN BREENE
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